

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/621,695	07/21/2000	Yulin Deng	7648.0006	4876	
7.	590 12/12/2001				
Finnegan Henderson Farabow Garret & Dunner LLP 1300 I Street NW Washington, DC 20005			EXAMI	EXAMINER	
			WILSON, DONALD R		
			ART UNIT	PAPER NUMBER	
			1713	3	
			DATE MAILED: 12/12/2001		

Please find below and/or attached an Office communication concerning this application or proceeding.

		H 8 3			
· •	Application No.	Applicant(s)			
Office Action Comments	09/621,695	DENG ET AL.			
Office Action Summary	Examin r	Art Unit			
	D. R. Wilson	1713			
The MAILING DATE of this communicati Period for Reply	ion appears on the cover sh t with	th corr sp ndenc address			
A SHORTENED STATUTORY PERIOD FOR THE MAILING DATE OF THIS COMMUNICAT - Extensions of time may be available under the provisions of 37 after SIX (6) MONTHS from the mailing date of this communica - If the period for reply specified above is less than thirty (30) day - If NO period for reply is specified above, the maximum statutory - Failure to reply within the set or extended period for reply will, be - Any reply received by the Office later than three months after the earned patent term adjustment. See 37 CFR 1.704(b). Status	TION. CFR 1.136(a). In no event, however, may a repiation. ys, a reply within the statutory minimum of thirty (y period will apply and will expire SIX (6) MONTHOW statute, cause the application to become ABA	ly be timely filed (30) days will be considered timely. 1S from the mailing date of this communication.			
1) Responsive to communication(s) filed of	on .				
	☐ This action is non-final.				
3) Since this application is in condition for	nis application is in condition for allowance except for formal matters, prosecution as to the merits is n accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.				
Disposition of Claims	, , , , , , , , , , , , , , , , , , , ,				
4) Claim(s) <u>1-66</u> is/are pending in the appl	lication				
4a) Of the above claim(s) is/are withdrawn from consideration.					
5) Claim(s) is/are allowed.					
6) Claim(s) is/are rejected.					
7) Claim(s) is/are objected to.					
8) Claim(s) <u>1-66</u> are subject to restriction a	nd/or election requirement				
Application Papers	navor oloolion requirement.				
9)☐ The specification is objected to by the Ex.	aminer				
10) The drawing(s) filed on is/are: a)		e Examiner			
Applicant may not request that any objection	· · · · · · · · · · · · · · · · · · ·				
11) The proposed drawing correction filed on	_	• •			
If approved, corrected drawings are require					
12) The oath or declaration is objected to by t					
Priority under 35 U.S.C. §§ 119 and 120					
13) Acknowledgment is made of a claim for f	foreign priority under 35 U.S.C. § 1	119(a)-(d) or (f).			
a) ☐ All b) ☐ Some * c) ☐ None of:					
1. Certified copies of the priority docu	uments have been received.				
3. Copies of the certified copies of the priority documents have been received in this National Stage					
	nal Bureau (PCT Rule 17.2(a)).				
14)☐ Acknowledgment is made of a claim for do	omestic priority under 35 U.S.C. §	119(e) (to a provisional application).			
 a) The translation of the foreign language 15) Acknowledgment is made of a claim for do 	- •				
Attachment(s)					
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-9-3) Information Disclosure Statement(s) (PTO-1449) Paper N	48) 5) Notice of Info	mmary (PTO-413) Paper No(s) prmal Patent Application (PTO-152)			
.S. Patent and Trademark Office PTO-326 (Rev. 04-01)	ffice Action Summary	Part of Paper No. 3			

Art Unit: 1713

DETAILED ACTION

Restriction Requirement

- Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-25 and 66 drawn to adhesive or coating, classified in class 524, subclass 555+.
 - II. Claims 26-44, drawn to method of making adhesive or coating, classified in class 524, subclass 555+.
 - III. Claims 45-62, drawn to method of recycling a paper product, classified in class 162, subclass 5+.
 - IV. Claim 63, drawn to a tape, classified in class 428, subclass 411.1+.
 - V. Claim 64, drawn to a label, classified in class 428, subclass 425.1+.
 - VI. Claim 65, drawn to a stamp, classified in class 283, subclass 71.
- 2. The inventions are distinct, each from the other because:
- 3. Inventions Group I are related to the inventions of Groups IV-VI as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an adhesive for making the different products of Groups IV-VI and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
- 4. Inventions of Group I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the

Art Unit: 1713

product as claimed can be used in a materially different process of using that product such as using the adhesive to bond non-paper products.

- 5. Inventions of Group I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as quarternizing the polymer after it is made to create the cationic charge.
- 6. The methods of Groups II-III are distinct from one another as they comprise different steps to make different products. The methods of Groups II-III are also distinct from the products of Group IV-VI products as the methods do not lead directly to the instantly claimed products. The inventions of Groups IV-VI are distinct from one another as they are different product forms.
- 7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and/or have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Election of Species Requirement

- 8. This application contains claims directed to the following genera of patentably distinct species of the claimed invention:
 - a. cationic polymer, specifically including the monomeric units present in the backbone and $^{\nu}$ grafted groups if present (Group I and III inventions),
 - b. tacky or hot melt (Group I-VI inventions),
 - c. tackifier including the specie of none present (Group I-VI inventions),
 - d. plasticizer including the specie of none present (Group I-VI inventions),
 - e. cationically charged monomers (Group II and IV-VI inventions),
 - f. copolymerizable backbone (Group II and IV-VI inventions),
 - g. methods of polymerization, as set forth in Claim 27 (Group II and IV-VI inventions),

Application/Control Number: 09/621,695

Page 4

Art Unit: 1713

- h. initiator including the specie of none-present (Group II and IV-VI inventions),
- cross-linker including the specie of none present (Group II and IV-VI inventions),
- j. water soluble monomers or macromers, including the specie of none present (Group II and IV-VI inventions),
- k. water present or absent (Group II inventions),
- I. alcohol present or absent (Group II inventions),
- 9. As appropriate for the elected group of inventions Applicant is required under 35 U.S.C. § 121 to elect a single ultimate disclosed specie for each of the above genera for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Where specific species are not identified in the claims applicant should elect a specific specie from the specification. An alternative method of election is to identify an Example which collectively exemplifies the elected species. Currently, Claims 1, 25, 45 and 63-64 are generic to the above species.
- 10. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
- 11. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).
- 12. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion to Restriction/Election Requirement

- 13. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
- 14. A telephone call was made to Ms. Lori_Ann Johnson on 12/6/01 to request an oral election to the above restriction requirement, but did not result in an election being made.
- 15. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named

Application/Control Number: 09/621,695

Art Unit: 1713

inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R. Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

D. R. Wilson Primary Examiner Art Unit 1713 Page 5